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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,107	02/16/2006	Hiroshi Hamamatsu	Q92742	2701
23373	7590	09/17/2008	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			KOSLOW, CAROL M	
			ART UNIT	PAPER NUMBER
			1793	
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			09/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/595,107

Applicant(s)

HAMAMATSU ET AL.

Examiner

C. Melissa Koslow

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

This action is in response to applicants' amendment of 25 June 2008. The amendments to the claims have overcome the 35 USC 101 rejection, the 35 USC 112 rejections, the provisional obviousness-type double patenting rejection, the 35 USC 102(a) rejection, the 35 UC 102(b) rejections and the 35 USC 103(a) rejection over U.S. patent 4,128,498. Applicant's arguments with respect to the remaining rejections have been fully considered but they are not persuasive.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 7,011,770. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed method produces the phosphor claimed in this application since this application teaches acid washing produces disilicate or digermanate phosphors having the claimed R values and since claim 6 in the patent teaches the produced phosphor is for VUV excited light emitting

devices, one of ordinary skill in the art would have found it obvious to use the phosphors resulting from the patented process in VUV excited light emitting devices, which suggested the use and device claimed in this application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 4-6 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 7,011,770

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This reference teaches acid washing europium activated silicon and germanium containing phosphors, such as those having the formula of claim 5 and using these phosphors in VUV excited light emitting devices. Thus the reference implicitly teaches VUV excited light emitting devices containing the taught phosphors. The taught process is that taught by applicants in this application and thus the phosphors resulting from the process of U.S. patent 7,001,770 is the same as that claimed in this application, absent any showing to the contrary. The reference teaches the claimed phosphors, devices and use.

Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/097767.

U.S. patent 7,161,298 is the national stage application for WO 03/097767 and thus is the translation for WO 03/097767.

This reference teaches VUV excited light emitting devices containing a phosphor having the formula $M_3MgSi_2O_8:Eu$, where M is at least one of Ca, Ba and Sr and the concentration of divalent europium in the phosphor is 45-95% and the concentration of trivalent europium in the phosphor is 5-55%. The formula of the host for the phosphor falls within that of claim 5. One of ordinary skill in the art would expect that this ratio of divalent to trivalent europium to give an R range that at least overlaps the claimed ranges, absent any showing to the contrary.

Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2003-238954

The translation for this reference teaches VUV excited light emitting devices containing a phosphor having the formula $MMgSi_2O_6:Eu$, where M is at least one of Ca, Ba and Sr and the concentration of divalent europium in the phosphor is 45-95% and the concentration of trivalent europium in the phosphor is 5-55%. The formula of the host for the phosphor falls within that of claim 5. One of ordinary skill in the art would expect that this ratio of divalent to trivalent europium to give an R range that at least overlaps the claimed ranges, absent any showing to the contrary.

Applicants' arguments with respect to the above rejections is the blanket assertion that the references do not disclose or suggest the claimed phosphor, but applicants have not provided any factual evidence that the taught phosphors of the references do not have an R range that falls within or overlaps the claimed R range nor they do not provide any explanation as to why the taught phosphors of the references, which are either produced by the same method used by

applicants to form the claimed phosphor (U.S. patent 7,011,770) or have a divalent europium to trivalent europium ratio which appear to overlap the ratio of the claimed phosphors (WO 03/097767) and JP 2003-238954), do not have a R range that falls within or overlaps the claimed R range. It is noted that this blanket assertion argument fails to comply with 37 CFR 1.111(b) because it amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The rejections are maintained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/cmk/
September 17, 2008

/C. Melissa Koslow/
Primary Examiner
Art Unit 1793